

Appl. No. : 10/804,985
Amdt. Dated: June 25, 2007
Reply to Office Action of March 21, 2007

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REMARKS

Claims 17-20, 23, 24 and 26-30 are currently pending in the present application. Of these claims, the current Action has rejected Claims 17-20, 23, 24 and 27-29 under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 5,443,311 to Kadlec et al. (hereafter "the '311 patent") in view of British Pub. 477,158 (hereafter "the GB '158 Reference") and further in view of U.S. Patent No. 5,245,801 to Boesvert (hereafter "the '801 patent"). Further, Claims 26 and 30 stand rejected under 103(a) as unpatentable over the '311 patent in view of GB '158 and further in view of U.S. Design Patent No. D 306'373 to Materna (hereafter "the '373 patent").

In light of the amendments above and arguments below, Applicants traverse the current rejections and contend that all remaining claims distinguish over the cited art and are in condition for allowance.

The '311 Patent

This patent is directed to a sliding work platform for a tool drawer that includes a flat panel with depending side and rear flanges and a depending tray along the front edge thereof. The disclosed cabinet may include "an end cabinet module 45, which is supported on one of the side walls 13 or 14 of the roll cabinet module 11 and may be provided with a plurality of drawers 47, all in a known manner." (See col. 3, lines 35-39). The drawers 47 are not disclosed as being capable of removal from the cabinet module 45. The module 45 is not open at the bottom to allow wheeled carts to be positioned within the module 45.

The '311 patent does not address the need to remove tools to a remote location for work. In fact, the '311 patent is focused on providing extra work space, using sliding work platforms 50, within the tool cabinet itself.

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The GB '158 Reference

This reference does not address the need for locking up tools from a remote location either. In fact, the GB '158 reference has nothing to do with tools. It is directed to a cabinet having a removable wheeled wagon or trolley upon which drinks can be made. The wagon is wheeled from the lockable cabinet as needed. However, the cabinet (i.e., locker) itself is not suspended from another secured station (i.e., tool cabinet). Rather, it is a stand alone structure.

The '801 Patent

This patent is directed to a cover housing arranged to receive a barbecue grill. Much like the GB '158 reference, this patent has nothing to do with locking up tools on a cart after use in a remote location. The disclosed grill cover is a stand alone structure.

The '373 Patent

This patent is directed to the aesthetics for a tool box add-on compartment. The disclosed compartment is rather small and is suspended at working level (i.e., a substantial distance from the ground) from a side of a tool cabinet. It does not have an open bottom, a doorway, or a lockable door for securing a rolling cart.

The Independent Claims

Currently, Claims 17, 26, 27 and 30 are independent. Claims 17, 26 and 30 are directed to a method for securing tools in a locker attached to a tool cabinet, while Claim 27 is quite similar, being directed to a method for providing a tool at a job site. As described in the background of the present application,

Large rolling tool cabinets are often used to secure tools which are kept at a job site. These tool cabinets may be placed at a central location in order to be easily accessible to those who use the tools. These tool cabinets are often heavily laden with tools, or other work articles, so it is often impractical to roll them to a particular work site. Consequently, small rolling carts are often employed to transport articles to the work site

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and back. At the end of the workday, the articles are removed from the rolling cart and placed back into the tool cabinet and secured.

Often it is desirable for mechanics and workmen to leave work pieces, equipment, or tools on a rolling cart undisturbed at the end of a work period, so that they may more easily continue their work where they left off the next period. Also, loading and unloading tools and other articles onto and off of the rolling cart can be quite time consuming, and sometimes objects will not readily fit into a tool cabinet. As a result, equipment and tools are often left on rolling carts unsecured.

These are problems addressed by the present invention. These are clearly not issues of any concern in the cited references. The only reference cited which discloses the use of a rolling cart is GB '158. However, this British 1937 reference describes use of a rolling cart to transport cocktails and make serving such cocktails easier.

The Examiner's position here is that:

it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the locker of Kaklecek with a locker having the characteristics provided by GB '158, since this arrangement would enhance the usage of Kadlecek's tool cabinet since the addition of the cart would increase functionality of the assembly due to the carts [sic] ability to be moved both as a unit with the cabinet and locker and individually depending upon the needs or application of the user.

In order to support a conclusion that a claim is directed to obvious subject matter, the cited references must impliedly suggest the invention *described by the claim*, or the Examiner must present a convincing line of reasoning as to why an artisan would have found *the claimed invention* obvious in light of the teachings of the cited references. See Ex Parte Clapp, 227 U.S.P.Q. 972 (PTO Bd. App. 1985). "[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Laskowski et. al., 10 U.S.P.Q. 2d 1397, 1398, (Fed. Cir. 1989), citing, In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In discussing the mandate of 35 U.S.C. §103, the Federal Circuit holds "it is the invention as a whole that must be considered in

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obviousness determinations. The invention as a whole embraces the structure, its properties *and the problem it solves.*" [Emphasis added]. In re Wright, 6 U.S.P.Q. 2d 1959 (Fed. Cir. 1988). It is not enough to just find components in the prior art.

On that point, the Federal Circuit has noted:

[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious [o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to recreate the claimed invention.
In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Unless the references suggest the particular combination themselves, they cannot show the actual invention was obvious. *In re Mahurkar Patent Litigation*, 831 F.Supp. 1354, 1374, 28 USPQ2d 1801, 1817 (N.D. Ill. 1993). The decomposition of an invention "into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis." *Id.*

Claims 17, 26, 27 and 30 are independent and each requires a (1) providing an open bottom locker, (2) attaching or suspending the locker to a tool cabinet, and (3) enclosing the tools placed on a rolling cart (or object) within the side walls of the locker. None of the cited references discloses these limitations.

The Examiner has acknowledged that the '311 patent fails to teach these required features of the claimed invention. Applicants accept and agree with this assessment of the particular cited art. However, the Examiner's rejection merely reconstructs the claimed invention by using references in unrelated technologies (i.e., liquor cabinets and outdoor grill covers) which disclose the existence of essential components of the invention, and then piecing such components together using the present application as a template.

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The Examiner states that the test of obviousness is "what the combined teachings of the references would have suggested to those of ordinary skill in the art." On this point, the Examiner is mistaken. The first step is to determine if one of ordinary skill in the art would have even considered the references were he understand the problem solved by the present invention. Here the Examiner suggests the skilled artisan designing tool cabinets and lockers would consider liquor cabinets from the 1930s and a barbecue grill cover. The assertion is without merit.

Accordingly, arguments for modification of the devices disclosed in either the '311 patent or GB '158 are of little merit. First, as acknowledged by the Examiner, neither reference teaches each and every element of the claimed invention. Second, those skilled in the art would never consider the cited references were they to even identify the problems solved by the present invention. Third, even if they were to be considered, none of the cited references discloses the steps of (1) providing an open bottom locker, (2) attaching or suspending the locker to a tool cabinet, and (3) enclosing the tools placed on a rolling cart (or object) within the side walls of the locker. Finally, even if those skilled in the art were to consider the cited references, combining these references with other references would serve only as a decomposition of the present invention "into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention...." Such is the *ex post* analysis *Mahurkar* specifically forbids.

Applicants contend that independent Claims 17, 26, 27 and 30, as amended, are patentably distinct over the cited art. Additionally, as each of the remaining claims is dependent from one of these allowable independent claims, merely adding additional limitations, the dependent claims are also considered to distinguish over the cited art. All pending claims are

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now considered to be in condition for allowance. Reconsideration of all rejections in light of the above amendments and arguments is respectfully requested.

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CONCLUSION

Claims 17-20, 23, 24 and 26-30 are currently pending in the present application. Several claims have been amended to more clearly point out the distinguishing features of the present invention. No new matter has been added to the claims. Applicants contend that all claims are in condition for allowance and requests reconsideration.

Should any formalities remain which can be addressed by Examiner amendment, Applicants request the undersigned attorney be contacted in order to expedite the prosecution of the present application.

Respectfully submitted,


By _____

Robert W. Diehl
PTO Reg. No. 35,118
Seyfarth Shaw LLP
Attorneys for Assignee
131 South Dearborn Street
Suite 2400
Chicago, Illinois 60603-5577
312-460-5000
312-460-7000 (fax)